

REMARKS

The Examiner has delineated the following inventions as being patentably distinct

Group I – Claims 1-8 and 10-20, drawn to an apparatus, a nucleic acid amplifier, classified in class 435, subclass 287.2

Group II – Claim 9, drawn to a method of amplifying a nucleic acid, classified in class 536, subclass 25.4.

Applicants provisionally elect, with traverse the invention of Group I, Claims 1-8 and 10-20, drawn to an apparatus, a nucleic acid amplifier.

The claims of Groups I and II are integrally linked as apparatus and method of use.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. §803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct. Restriction between a product and a method for its production is proper when the product can be produced by another method. Applicants respectfully traverse the restriction requirement on the ground that the Examiner has not provided sufficient reasons or examples to support patentable distinctness. Product and method of making said product are interdependent and should be examined together on the merits, especially wherein the sole disclosed utility of the apparatus is that recited in the specification. Different classification of subject matter to be divided is not conclusive proof of independent status and divisibility.

Method of making and apparatus used (in this case to amplify a nucleic acid) are considered related inventions under 37 C.F.R. 1.475(b) and unity of invention between the groups exists.

Applicants respectfully traverse on the additional grounds that the Office has not shown that a burden exists in searching the entire application.

Further, the M.P.E.P. § 803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions.”

Applicants submit that a search of all the claims would not constitute a serious burden on the Office. In fact, the International Search Authority has search all of the claims together. As the Office has not shown evidence that restriction should now be required when the International Preliminary Examination Report did not, the Restriction is believed to be improper. 37 C.F.R. 1.47(b) provides in relevant part that a national state application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to product, manufacture of said product and use of said product.

For the reasons recited above, Applicants request that the Restriction Requirement be withdrawn.

Further, Applicants reserve the right to file a divisional application on the non-elected subject matter, if so desired, and be accorded the benefit of the filing date of the parent application.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits and an early notice of such action is earnestly solicited.

Respectfully submitted,

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